REMARKS

In the Office Action, the Examiner noted that claims 28-39 and 82-91 are pending in the application, that claims 28-34, 36-39, 82-88, 90 and 91 are rejected, and that claims 35 and 89 are allowable over the prior art of record. Applicant graciously acknowledges the Examiner's indication of allowable subject matter.

By this Amendment, claims 28, 35, 38 and 82 have been amended, and no claims have been added or cancelled. Therefore, claims 28-39 and 82-91 are pending in the application. The amendments to the claims are supported by the specification and figures. Accordingly, no new matter is believed to have been introduced in the present application.

The Examiner's rejections are traversed below.

Rejection Under 35 U.S.C. Section 103

Claims 28-34, 36-39, 82-88, 90 and 91 stand rejected under 35 U.S.C. Section 103 as being unpatentable over Lasher et al. (U.S. 5,771,657) combined with Schoonen et al. (U.S. 6,230,927). Applicant respectfully traverses these rejections.

Without conceding that Lasher et al. discloses the combination of features in the presently claimed invention, the Examiner admits that Lasher et al. does not disclose a non-countable medication package being pre-packaged and dispensed. The Examiner contends, however, that Schoonen et al. includes a mechanism for dispensing pre-packaged medication per prescription order.

Applicant disagrees in that Shoonen et al. cannot be combined with Lasher et al., and even if combined, the proposed combination does not result in the currently claimed invention.

In particular, the Schoonen et al. patent merely discloses an independent automatic dispensing system for dispensing a prepackaged drug. The dispenser comprises at least one cartridge which, in use, is filled with prepacked drugs, wherein the drugs are each provided with a drug identification code and the cartridge with a cartridge identification code. There are further provided conveying means for selecting a prepacked drug from the cartridge and for subsequently conveying the selected drug from the cartridge. By means of detecting means, the drug identification code of a selected drug and a cartridge identification code of the at least one cartridge are detected and fed to a control unit for further processing.

In Schoonen et al., a prescription signal is fed to the control unit 38. The control unit can then check whether the prescription of the chipcard corresponds to the prescription that was fed on-line. Next, the first sensor 53 detects the cartridge identification code of the cartridge to which it has been moved. This cartridge identification code is fed to the control unit 38, which checks whether the drug identification code of the drug selected by the pincer-shaped gripper 42 and detected by the first sensor 53 corresponds to the drug identification code determined for the relevant cartridge on the basis of the prescription signal from the data storage unit 60. When the cartridge identification code detected by the detecting means at that location, i.e. the identification code of the cartridge that is selected by the pincer-shaped gripper, corresponds to the cartridge identification code that is determined for the location in

question from the data storage unit, the control unit controls the first driving block 45' in such a manner that the push block 42' is driven inwards via the second open end 4 of the selected cartridge. The drug is pressed outwards at the first open end 2 of the selected cartridge. At the same time, the control unit 38 controls the gripper 42 in such a manner that it grips the drug, partly slid outwards, for conveying the drug from the selected cartridge to the second sensor 56. By means of the second sensor 56, the drug identification code of the relevant drug is then determined. The identification code of the drug positioned on the table 54 is fed to the control unit 38 via a signal S_2. The control unit 38 checks whether the detected drug identification code corresponds to the drug identification code determined for the relevant cartridge from the data storing means. If this is the case, the control unit controls the gripper device 39 in such a manner that the relevant drug is conveyed further to the printer 58. The printer 58 provides the drug with an inscription comprising for instance the drug, the dosage, and in particular the patient's name. This inscription can for instance be printed on a label for the drug to be released. After this, the control unit controls the gripper device 39 for further conveying and, accordingly, releasing the drug in question.

Accordingly, there is no suggestion or description as to how one might attempt to combine the Schoonen et al. patent with the Lasher et al. patent. In addition, even if the Lasher et al. patent is combined with the Schoonen et al. patent, the proposed combination would not yield the features and advantages of the present invention.

As stated in MPEP Section 2142 ("Legal Concept of *Prima Facie* Obviousness"):

To establish a *prima facie* case of obviousness, ...the **prior art reference (or references when combined), must teach or suggest all the claim limitations**. The

> teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

Neither Lasher nor Schoonen provide any teaching, suggestion or motivation to adapt or modify the prior art. For example, with regard to motivation to combine, Schoonen, in contrast to the claimed invention, is concerned with a very specific problem. Namely, Schoonen states that:

> [t]he object of the present invention is to **increase the reliability of the known dispenser** still further. Moreover, the known dispenser has as a drawback that it does not offer any possibilities of **loading the dispenser in one operation with large amounts of possibly mutually different drugs.** The object of the invention is to provide a dispenser which does have this possibility and wherein the reliable operation of the dispenser is moreover optimized.

In view of the very limited focus of Schoonen, it is apparent that Schoonen does not provide a "teaching or suggestion to make the claimed combination," as required by MPEP Section 2142.

In addition, the overall functionality of Schoonen is different that the present invention. For example, Schoonen describes a cartridge which is filled with prepacked drugs, and the drugs are each provided with a drug identification code and the cartridge with a cartridge identification code, which is again not at all related to the present invention.

Applicant has further amended the claims to provide the appropriate scope of protection that Applicant is seeking, and to make express what Applicant considers to be inherently claimed.

For example, with respect to Claim 28, without conceding that the cited prior art discloses any of the elements of the present invention, Applicant respectfully submits that the prior art does not show or suggest the combination of limitations in claim 28, when claim 28 is interpreted as a while.

For example, claim 28 recites the following, in combination, a "method for filling at least one order, the method comprising the steps of: receiving at least one bottle containing pills individually counted and at least one package containing pharmaceutical products without having been pre-designated for the at least one order when the at least one package was created. The "at least one bottle is specifically designated for the at least one order and wherein the at least one order includes at least one prescription for the at least one package." In addition, claim 28 recites in combination, "detecting at least one identification information associated with the at least one bottle, and detecting at least one other identification information associated with the at least one package," and "automatically combining the at least one bottle and the at least one package into the container when the at least one identification information associated with the at least one bottle and the at least one other identifier information associated with the at least one package correspond to the at least one prescription order."

Claim 28 also recites "sending the at least one bottle and the at least one package to at least one recipient corresponding to the at least one order, to thereby fill the at least one order."

Accordingly, Applicant submits that the combination of limitations recited in claim 28 patentably distinguishes over the prior art cited by the Examiner. Withdrawal of this rejection is respectfully requested.

In addition, Applicant respectfully submits that claims 29-34, 36-39, 82-88, 90 and 91 also patentably distinguish over the prior art for the specific combination of limitations recited in each of the claims, when each claim is interpreted as a whole. Withdrawal of the rejection of these claims is respectfully requested.

For example, dependent claim 32 recites, in combination, "The method of claim 31, further comprising the step of configuring the at least one label into a sufficiently small footprint to be affixed on the at least one package." None of the prior art appears to show or suggest this feature, in combination.

Accordingly, Applicant respectfully submits that claims 29-34, 36-39, 82-88, 90 and 91 patentable distinguish over the prior art for the specific combination of limitations recited in each of the claims, when each claim is interpreted as a whole. Withdrawal of these rejections is respectfully requested.

CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior

art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

Serial No. 10/777,126
Attorney Docket No. 103864.133US2

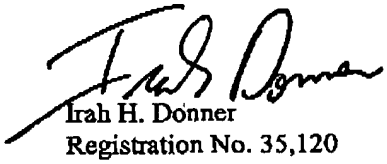
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP



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